Our Case No. 10710-611
PTG 0791 PUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gerhard Josef Karl Weusthof et al.

Serial No. 10/056,297

Filing Date: January 25, 2002

For Light Beam Alignment System

Examiner: Ghassem Alie

Group Art Unit No. 3724

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed December 19, 2005 and the Advisory Action dated April 5, 2006, Applicants have filed this Pre-Appeal Brief Request for Review, as well as the accompanying Notice of Appeal. Because these papers are being submitted within four months of mailing of the final Office Action, Applicants file a Petition and fee for a one month extension of time. The most recent amendments to the claims in this application were filed in the Amendment dated September 21, 2005, and are already of record.

Claims 1-19 are pending in this application. Claims 4, 5, 14-16, 18, and 19 have been withdrawn from prosecution based on a restriction requirement. Claims 1-3, 6-13, and 17 have been twice rejected and Applicants wish to avail themselves of

the expedited PTO procedure for appeals in accordance with the procedures designated in the USPTO's Official Gazette notice dated July 12, 2005.

Claims 1, 2, 6, 8, 13, and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. patent number 6,035,757 to Caluori ("Caluori") in view of PCT application number WO 99/02310 to Van Osenbruggen ("Van Osenbruggen") and U.S. patent number 4,648,610 to Hegyi ("Hegyi"). The rejection is set forth in full in the final Office Action mailed on December 19, 2005. Applicants respectfully traverse the rejection. The Examiner has failed to provide a *prima facia* case of obviousness because one skilled in the art would not have been motivated to combine Caluori with Van Osenbruggen and Hegyi without improperly referring to the claimed invention in hindsight, and the combination of references without Hegyi do not disclose all of the limitations of the claimed invention.

Caluori discloses a laser arbor that is mountable on an arbor of many different types of rotary saws and is powered from a battery located in the laser arbor. In operation, the Caluori laser shines a laser light line onto the workpiece to identify the cutting line of the saw blade. Van Osenbruggen discloses a plurality of tools with lights that are located on the fixed portions of the tools. Van Osenbruggen does not disclose that it is possible to mount a light on a rotating portion of a tool. As noted by the Examiner, Van Osenbruggen discloses that when the tool is an "electric power tool," it is possible to power a lamp from the tool itself with "a few turns of wire wound within an inductor assembly." Van Osenbruggen, p. 13, ll. 21-24. However, this statement merely teaches that the light can be powered using the electricity source for the "electric power.tool." Indeed, if the tool's rotation were generating the electricity for the light, the tool would not need to be "electric"; it could be air powered or even hand powered.[1] Further, the inductor's purpose is to evenly control the electricity flow to the light. Thus, one would not even look to Van Osenbruggen when attempting to construct a laser arbor that is not battery powered.

Further, Caluori teaches away from a combination with Van Osenbruggen's light source. The lights in Van Osenbruggen illuminate the entire cutting area, while Caluori's laser light line illuminates only the cutting line. As understood by those or ordinary skill in the art, the use of Van Osenbruggen's light in combination with

[1] Additionally, Van Osenbruggen discloses tools that are electric but not rotary, such as the jigsaw at FIG. 11. This further supports that the language relied on by the examiner cannot refer to the tool's output, but rather the tool's power source.

Caluori's laser light line would reduce the visibility of Caluori's light line because the contrast between the laser light line and the remainder of the workpiece would be reduced with the workpiece being illuminated by Van Osenbruggen's light. Accordingly, the combination of Caluori and Van Osenbruggen renders Caluori unsuitable for its intended purpose of providing a laser light line to identify the cutting line of a rotary saw. MPEP § 2143.02. Accordingly, the combination of Caluori and Van Osenbruggen is improper.

The combination of references of record is also improper because the modification of Caluori required to provide a light located on the rotor powered from current generated on the rotor would dramatically change the principle of operation of Caluori. *See In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959); MPEP § 2143.01.

Because Caluori is powered from batteries located within the Caluori housing, no other modifications to the rotary saw used with Caluori are required when attaching Caluori to the arbor or a rotary saw. If Caluori was modified to include a circuit electrically connected to the laser to provide power to the laser that includes a portion secured to the non-rotating portion of the saw (as is required by claim 1), or a generator electrically coupled to the light source that includes a rotor and a stator secured to the housing (as required by claim 8), or a permanent magnet secured to a fixed guard (as required by claim 17), the non-rotating portions of the rotary saw would also need to be significantly modified to include the claimed structure. These required changes to Caluori and the rotary saw used with Caluori would change the principle of operation and use of Caluori. *See In re Ratti*, 270 F. 2d at 813. Thus, one of ordinary skill in the art would not have been motivated to modify Caluori to provide a laser device that required structural modifications to the non-rotating portion of the tool, without impermissible hindsight to the claimed invention. Accordingly, the combination of cited references with Caluori is improper.

Hegyi discloses a light emitting roller skate wheel. Although Hegyi discloses that the light on the wheel is powered from current generated within the wheel, the combination of Caluori, Van Osenbruggen, and Hegyi is improper because Hegyi is not analogous to the claimed invention and therefore cannot be properly combined with Caluori and Van Osenbruggen to reject the claims in this application. *See* MPEP 2141.01(a). Because Hegyi is not analogous art to the claimed invention, Hegyi cannot logically be used to reject the claims of this application without the improper use of hindsight, and one of ordinary skill in the art would have not

considered Hegyi when attempting to solve the problems that the claimed invention is concerned.

In order for a reference to be properly combined to support an obviousness rejection, the reference must either be in the same field of endeavor as the claims, or the reference must be reasonably pertinent to the particular problem with which the claimed invention is concerned. *See In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006); *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); MPEP 2141.01(a)(I). Applicant respectfully submits that the combination of Hegyi with the other cited references is improper because Hegyi is not analogous to the claimed invention. *See Jurgens v. McKasy*, 927 F.2d 1552, 1559 (Fed. Cir. 1991).

Specifically, Hegyi is directed to a roller skate wheel with a light that illuminates when the wheel is rotated. Applicant submits that one of skill in the art of cutting tools, such as rotary saws, would not consider Hegyi to be within the claimed endeavor. Cutting tools and saws are generally used by those of skill in the art to cut workpieces into specific sizes and along predetermined lines. In contrast, the roller skates are used for transportation and for recreational exercise.

Similarly, one of ordinary skill in the art would not consider the Hegyi roller skate to be reasonably pertinent to solve the problem that the claimed invention is concerned with. When determining whether the references are reasonably pertinent to the problem to be solved, the Examiner must "consider 'the reality of the circumstances' – in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." *In re Kahn*, 441 F.3d at 987 (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)).

The claimed invention is concerned with the problem of precisely cutting a workpiece. In contrast, Hegyi is concerned with providing a roller skate wheel that includes a light that flickers when the wheel rotates, for the aesthetic qualities of the light and for allowing others to see the roller skate user in low light situations. Neither of these potential uses are reasonably related to the problem the claimed invention addresses, and accordingly, one of ordinary skill in the art of cutting tools would not have reasonably considered a roller skate with lights within the wheels to be related to the problem to be solved without the improper benefit of hindsight.

Accordingly, Hegyi is not from the same field of endeavor as the claimed invention and one of ordinary skill in the art would not reasonably, using common

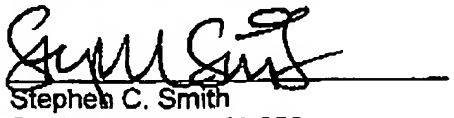
sense, consider a roller skate to be pertinent to the problem that the claimed invention is concerned with. Therefore, Hegyi was improperly combined with Caluori and Van Osenbruggen to reject claims 1-3, 6-13, and 17.

Because Hegyi may not be properly combined with Caluori and Van Osenbruggen the Examiner's is left to argue that the combination of only Caluori and Van Osenbruggen is obvious (assuming *arguendo* that Caluori and Van Osenbruggen could be properly combined). This rejection fails to provide a *prima facia* case of obviousness, not only has this combination improperly been made in hindsight, as discussed above, but this combination fails to disclose or suggest all of the limitations of independent claims 1, 8, and 17.

For example, the combination of Caluori and Van Osenbruggen do not disclose or suggest "a circuit electrically connected to the laser ... wherein electric current to power the laser is generated on the spindle and the spindle has no electrical connections with the non-rotating portion of the saw" as in claim 1. Similarly, the combination does not disclose "a generator electrically connected to the light source ... the generator includes a rotor ... wherein the rotor has no electrical connections with a non-rotating portion of the saw" as in claim 8, and "a generator electrically connected to the light source ... having a permanent magnet secured to a fixed guard and a coil rotated by the spindle, wherein the spindle has no electrical connections with a non-rotating portion of the saw" as in claim 17. Moreover, there is no analogous prior art of record in this case that discloses or suggests these limitations that is combinable with Caluori and Van Osenbruggen.

For at least the reasons identified and discussed above, Applicants respectfully traverse the rejections of independent claims 1, 8, and 17. Dependent claims 2-3, 6-7, and 9-13 are patentable at least because the independent claims that they refer to are patentable. The undersigned respectfully requests that the rejections in the present application be withdrawn and the application be allowed.

Respectfully submitted,



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